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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,237	12/23/2004	Shizue Ito	1217-045843	2512
28389 7590 02/05/2009 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219				
EXAMINER				
MISKA, VIT W				
ART UNIT		PAPER NUMBER		
2833				
MAIL DATE		DELIVERY MODE		
02/05/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/519,237

**Applicant(s)**

ITOU ET AL.

**Examiner**

Vit W. Miska

**Art Unit**

2833

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) 1-30, 32, 36, 40, 43-45 and 47-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31, 33-35, 37-39, 41, 42 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/2005, 6/2006, 1/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election without traverse of the species of Figs 16-17 in the reply filed on 10/17/2008 is acknowledged.

Applicant indicates that claims 31-42 and 46 are readable on the elected species. However, claims 32, 36 and 40 are not considered readable on the elected species, as the description of Figs. 16-17 lacks the "0" gap D1 set forth in these claims.

Claims 1-30, 32,36,40, 43-45 and 47-80 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/17/2008.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 31, 33 and 42 are rejected under 35 U.S.C. 102(b) or 102(e) as being anticipated by Megner et al (U.S. Pat. 6411569).
3. The reference discloses a radio controlled watch comprising: an antenna 28 for receiving a radio wave including time information (col. 3, line 42); a watch device 24 for causing a display portion to display time information such as a present time (col. 3, line 42) by the radio wave received by the antenna; and a watch case 13 for accommodating the antenna and the watch device, wherein the watch case is constituted by a metal (see col. 2, line 59), wherein the antenna is provided part from the watch case (see Fig. 1), wherein the watch case is made from steel or titanium (col. 2, line 54).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 34-35, 37-39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Megner et al. The reference does not set forth the dimensions of watch case 13, the back cover, or the gap between the case and antenna. With respect to the gap D1 between the internal surface of the watch case and the antenna, Megner et al disclose a gap as seen in Fig. 1. The placement of the antenna with respect to the metallic casing would be an obvious design matter for one of ordinary skill in the art selected on the basis of the optimum reception of signals achieved. One of ordinary skill in the art would be familiar with interference caused by a metallic casing and select a suitable spacing gap to provide sufficient reception quality with the selected watch dimensions. Applicant claims a wide range for gap D1, from 0 to 40,000 microns, thus suggesting that any dimension within this range is not critical. Absent any unobvious criticality, the gap dimensions are considered obvious design criteria.

5. With respect to the thickness of the casing and back cover, these dimensions, absent unobvious criticality, are considered design criteria that one skilled in the art would select to achieve optimum radio reception, with consideration of the aesthetic design of the watch. Again, applicant's claimed range of 300-5000 microns for the watch case thickness, and 100-5000 microns for the back cover thickness, suggests non-criticality. Thus, one skilled in the art would select appropriate dimensions in Megner et al to achieve the most favorable reception quality and aesthetic appearance.

6. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Megner et al. Megner et al do not disclose a metallic back cover 16. However, it is conventional to provide a metallic case with a metallic back cover in a wristwatch. It would be obvious for one of ordinary skill in the art to replace back cover 16 of Menger et al with a metallic back cover to provide durability to the watch, if reduced reception quality were not a factor in design considerations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Renee Luebke can be reached on 571-272-2009. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/s/it W. Miska/  
Primary Examiner, Art Unit 2833